

The opinion in support of the decision being
entered today is not binding precedent of the Board

Paper No. ~~64~~ 64

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

MAR 18 2003

RONALD A. SINK
Junior Party

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

v.

RUSSELL F. SCOTT and JOHN E. TISFANY
Senior Party

Patent Interference No. 104,068

Before CAROFF, METZ, and HANLON, Administrative Patent Judges.
CAROFF, Administrative Patent Judge.

JUDGMENT PURSUANT TO 37 CFR § 1.640(e)

An order to show cause (Paper No. 58) was issued in this
interference on February 14, 2003, pursuant to the provisions of
37 CFR § 1.640(d)(3), based on the fact that junior party Sink
alleged no date in its preliminary statement prior to the
effective filing date accorded to Scott et al., the senior party.

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Sink filed a timely response and a motion for testimony under 37 CFR § 1.635 (Paper No. 62). Sink's response and motion for testimony are both fatally flawed and, therefore, are dismissed for the following reasons:

The response to the show cause order does not request that a final hearing be set to review any decision which is the basis for the show cause order, or to review any other issue decided in the associated Decision on Motion (Paper No. 58). Rather, for the first time in these proceedings, Sink raises the issue of "prosecution laches" as a basis for challenging the patentability of Scott's involved claims. According to Sink, the doctrine was articulated by the Federal Circuit in Symbol Technologies, Inc. v. Lemelson Med., Educ. and Res. Fdn., 277 F.3d 1361, 61 USPQ2d 1515 (Fed. Cir. 2002), and extended in In re Bogese, 303 F.3d 1362, 64 USPQ2d 1448 (Fed. Cir. 2002), cases decided on January 24, 2002 and September 13, 2002, respectively.

Sink has not shown good cause why the issue of "prosecution laches" could not have been raised earlier in these proceedings by way of a miscellaneous motion under 37 CFR § 1.635. Accordingly, the belatedly raised issue of "prosecution laches" will not be considered in this proceeding. 37 CFR § 1.645(b).

Furthermore, we note that even if Sink had raised the "laches" issue in a timely manner, the burden would have been on

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Sink to show not only a delay in prosecution of the senior party's series of co-pending applications but, also, that the delay was an unreasonable delay attributable to the senior party. In this regard, we note that the parent applications of Scott et al. were subject to secrecy orders for over 20 years, a fact not recognized or addressed in the arguments presented in Sink's response.

The motion for testimony is dismissed since it fails to satisfy the mandatory requirements of 37 CFR § 1.637(b).

For the foregoing reasons, judgment on the record is in order and is rendered as follows:

Judgment

Sink has failed to show good cause why judgment should not be entered against Sink. Accordingly, pursuant to the order to show cause of February 14, 2003, judgement is hereby entered as follows:

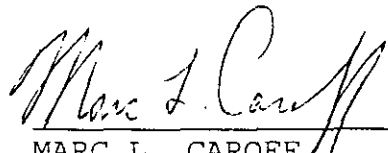
Judgment as to the subject matter of the sole count in issue is hereby awarded to Scott et al., the senior party.


Accordingly, Sink is not entitled to his patent claims 1-2 and 5-9 corresponding to the count.


On the record before us, Scott et al., are entitled to a patent containing their claims 12-13 and 16-20 corresponding to

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the count, but are not entitled to a patent containing their claims 14-15 corresponding to the count.¹


_____)
MARC L. CAROFF)
Administrative Patent Judge)


_____)
ANDREW H. METZ)
Administrative Patent Judge)


_____)
ADRIENE LEPIANE HANLON)
Administrative Patent Judge)

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¹ Scott et al., claims 14-15 were found to be unpatentable in the Decision on Motions (Paper No. 58). Scott et al. have not sought review of that decision.

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